

Remarks

Claims 15 and 21 have been amended by adding the feature that the porous insulating film does not contain a dense layer on any of its side surfaces. Specification support for this amendment may be found, *inter alia*, in Figures 1 and 7 to 9, as described at page 4, lines 24-26 and page 5, lines 13-22. No new matter has been introduced by any of the amendments.

1. Rejection under 35 U.S.C. § 102(b) or § 103(a) over the ‘856 patent

The Examiner has maintained his rejection of claims 15-24 and 26 as allegedly anticipated by, or in the alternative, as allegedly obvious over JP 2-2856 (“the ‘856 patent”). The Examiner asserts that the ‘856 patent teaches a porous film for liquid filtration comprised of a polyimide resin with Applicants’ claimed mean pore size and thickness that is obtained from the combination of a biphenyltetracarboxylic dianhydride component and a diaminodiphenylether component. The Examiner acknowledges that the ‘856 patent does not disclose a film having (i) fine continuous channels reaching to both surfaces in a non-linear fashion or (ii) Applicants’ claimed porosity, air resistance, heat resistance, heat shrinkage or dielectric constant. However, the Examiner considers these properties to be inherent in the films taught by the ‘856 patent.

Applicants respectfully disagree with the Examiner’s continued rejection of the claims over the ‘856 patent. Applicants submit that the ‘856 patent requires the presence of a dense layer on the surface of the described films. For example, the abstract of the ‘856 patent states that the purpose of the invention is “to obtain a porous film having excellent mechanical property...” At page 3 of the earlier submitted partial English-language translation of the ‘856 patent, it is stated that

“...the larger the thickness of the dense layer, the higher the mechanical strength, and the smaller the thickness the higher the water flux. Therefore, the thickness can be selected depending on the use...” (lines 5-9).

Applicants submit that the above language, coupled with the stated purpose of the invention (*i.e.*, a film having excellent mechanical property), indicates that a dense layer is required and that only the thickness of the dense layer is variable. Additional evidence of the necessity of a dense layer may be found in the sole example in the specification, which describes the preparation of a porous film containing a dense

layer with a thickness of about 15 μm . There is no teaching or suggestion in the '856 patent of a film that does not contain at least one dense layer. The language in the specification that the structure of the film is not particularly limited should not be used to encompass structures that were clearly not contemplated by the patentees. As amended, the claims recite that Applicants' insulating film does not contain a dense layer on any of its side surfaces. Accordingly, Applicants respectfully request that the rejections of claims 15-24 and 26 as allegedly anticipated by or obvious in view of the '856 patent be withdrawn.

2. Rejection under 35 U.S.C. § 103(a) over the '856 patent in view of Dorval

The Examiner also maintains his rejection of claims 25 and 27 as allegedly being unpatentable over the '856 patent in view of U.S. Patent 5,547,833 to Dorval *et al.* ("Dorval"). The Examiner acknowledges that the '856 patent does not teach that the pores are arranged substantially parallel to the film's surface, but cites Dorval for this teaching.

Applicants respectfully disagree with the Examiner's continued rejection of the claims as allegedly obvious over the '856 patent in view of Dorval. As stated in section 1 above, the '856 patent neither teaches nor suggests Applicants' claimed porous insulating film. Dorval is unable to remedy this deficiency. Accordingly, Applicants respectfully request that the rejection of claims 25 and 27 as allegedly being unpatentable over the '856 patent in view of Dorval be withdrawn.

3. Double Patenting Rejection

Claims 15-24 and 26 are provisionally rejected under obviousness-type double patenting over claims 15-31 of copending Application No. 10/784,982.

Applicants disagree with the grounds for this provisional rejection. However, in an effort to expedite prosecution of the subject application, Applicants intend to file a terminal disclaimer over Application No. 10/784,982 if the claims in Application No. 10/784,982 are found allowable.

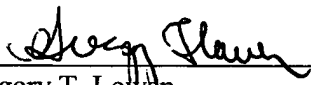
4. Conclusion

The foregoing amendments and remarks are being made to place the application in a condition for allowance. Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner find that an interview would be helpful to further prosecution of this application, he is invited to telephone the undersigned at his convenience.

Except for issue fees payable under 37 C.F.R. 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or to credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **Constructive Petition for Extension of Time** in accordance with 37 C.F.R. 1.136(a)(3).

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